

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Benny Bang-Andersen et al.	Art Unit :	1624
Patent No. :	7,772,240	Examiner :	Emily Bernhardt
Issue Date :	August 10, 2010	Conf. No. :	3519
Serial No. :	10/568,292		
Filed :	August 14, 2006		
Title :	TRANS-1(6-CHLORO-3-PHENYLINDAN-1-YL)-3,3-DIMETHYLPIPERAZINE		

Commissioner for Patents  
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**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)**

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to adjust total PTA from 320 days to 184 days is respectfully requested.

**REMARKS**

(1) Measuring Overlap of “A Delay” and “B Delay”

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

**CERTIFICATE OF MAILING BY EFS-WEB FILING**

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: October 1, 2010.

(2) Measuring “B Delay” for a National Stage Filing under 35 U.S.C. § 371

For a national stage filing under 35 U.S.C. § 371(b), application pendency must be measured from the date that marks the expiration of 30 months from the priority date of the international application (i.e., not from the date on which the application fulfilled the requirements of 35 U.S.C. § 371). The priority date of the instant patent is August 18, 2003; thus the date that is 30 months from the priority date is Saturday, February 18, 2006. As this date falls on a weekend, the expiration of the 30-month period extends to the following business day, or Tuesday, February 21, 2006 (given the President’s Day holiday on Monday, February 20, 2006). Thus, the “actual filing date” for purposes of calculating “B Delay” under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b), is February 21, 2006.<sup>1</sup>

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before October 14, 2007 (the date that is fourteen months after August 14, 2006, the date on which the application fulfilled the requirements of 35 U.S.C. § 371). See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1). The PTO mailed the first non-final Office Action on May 13, 2008, thereby according a PTO Delay of 212 days. Patentee does not dispute the PTO’s calculation for this “A Delay.”

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 212 days.

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<sup>1</sup> In contrast to reliance on “the expiration of 30 months from the priority date” for measuring “B Delay,” the beginning of the relevant period for purposes of calculating “A Delay” is the date on which an international application fulfills the requirements of 35 U.S.C. § 371. See 35 U.S.C. § 154(b)(1)(A)(i)(II) and 37 C.F.R. § 1.702(a)(1).

“B Delay”

The present application is a national stage filing under 35 U.S.C. § 371 of international application number PCT/DK2004/00546, filed August 18, 2004, which claims its earliest benefit of priority to United States Provisional Application No. 60/496,058, filed August 18, 2003, and Danish Application No. PA 2003 01180, filed August 18, 2003.

The national stage for the present application “commenced” under the provisions of 35 U.S.C. § 371(b), i.e., upon expiration of 30 months from the priority date of the international application.<sup>2</sup> As a result, and as discussed above, the date that the national stage commenced was February 21, 2006.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1). In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a further Office Action or a Notice of Allowance. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In the present application, a Notice of Appeal was filed on August 3, 2009, a Request for Continued Examination was filed on March 3, 2010 (prior to the mailing of a further action by the Office), and the patent issued on August 10, 2010. Under these circumstances, the period beginning on the date the Notice of Appeal was filed (August 3, 2009) and continuing through patent issuance (August 10, 2010) must be excluded from the three year delay calculation.

The period beginning on February 22, 2009 (the day after the date that is three years after February 21, 2006, the date that the national stage commenced), and ending on August 2, 2009 (the day before the date that a Notice of Appeal was filed), is 162 days in length.

The PTO calculated 374 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO’s calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 162 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

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<sup>2</sup> A complete request for early processing under 35 U.S.C. § 371(f) was not filed with the present application.

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

October 15, 2007, to May 13, 2008.

As detailed above, "B Delay" accumulated during the following period:

February 22, 2009, to August 2, 2009.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

(1) Points of Agreement with PTO Applicant Delay Calculation

(a) Late Reply to Office Action

A reply to an Office Action was due on or before August 13, 2008 (the date that is three months after May 13, 2008, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on November 13, 2008, thereby according an Applicant Delay of 92 days. See 37 C.F.R. § 1.704(b). Patentee does not dispute the PTO's calculation for this Applicant Delay from August 14, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to November 13, 2008.

(b) Late Reply to Office Action

A reply to an Office Action was due on or before May 3, 2009 (the date that is three months after February 3, 2009, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on August 3, 2009, thereby according an Applicant Delay of 92 days. See 37 C.F.R. § 1.704(b). Patentee does not dispute the PTO's calculation for this Applicant Delay from May 4, 2009 (the day after the date that is three months after the date on which the Office Action was mailed), to August 3, 2009.

## (2) Point of Disagreement with PTO Applicant Delay Calculation

### Request for Corrected Filing Receipt After Allowance

Patentee filed a Request for Corrected Filing Receipt on May 21, 2010, subsequent to the mailing of a Notice of Allowance. As part of the request for correction of the filing receipt, Patentee also submitted a Supplemental Application Data Sheet containing the changes to be made by the correction. The Office responded to the filing on May 26, 2010, by issuing a Corrected Filing Receipt.

Patentee was accorded a delay of 82 days for this post-allowance filing. Patentee respectfully submits that the calculated Applicant Delay of 82 days is incorrect and that a delay of 6 days is appropriate for this post-allowance filing, for delay occurring between May 21, 2010 (the date on which the post-allowance filing was made) and May 26, 2010 (the date on which the Office mailed its response). See 37 C.F.R. § 1.704(c)(10). It appears that the erroneous calculation made by the Office resulted from a failure to stop the running of the period of delay upon the Office's mailing of a response (i.e., a Corrected Filing Receipt) on May 26, 2010. Instead, the Office appears to have inadvertently calculated the period of delay as ending on the day of patent issuance, despite the Office having mailed a response to Patentee's paper long before that time.

## (3) Summary of Proper Applicant Delay Calculation

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 190 days (i.e., the sum of 92 days, 92 days, and 6 days).

### Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

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Page : 6 of 6

Attorney's Docket No.: 27507-0164001 / 463-US-PCT

### Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 320 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 374 days (i.e., the sum of 212 days of "A Delay" and 162 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 190 days; and
- 3) Total PTA should be calculated as 184 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 27507-0164001.

Respectfully submitted,

Date: October 1, 2010

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